

REMARKS

Upon entry of this Amendment, claims 1-12 are all the claims pending in the application. Claims 11 and 12 have been added. Applicant thanks the Examiner for acknowledging that at least claims 2-4, and 6-8 recite patentable subject matter as each of these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claims 1, 5, 9 and 10 presently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang et al. (USP 6,323,919) in view of Sonehara (USP 4,870,484). For the reasons set forth below, Applicant respectfully traverses the rejection and requests favorable disposition of the application.

Argument

Applicant has amended claim 2 to be in independent form by including all the features of claim 1. Applicant submits that by this amendment each of claims 2-4, and 6-8 are now in condition for immediate allowance.

In regard to claim 1, Applicant submits that the Examiner has failed to set forth a *prima facie* case of obviousness. More specifically, the Examiner has not provided any motivation, gleaned from the prior art, for a skilled artisan to make the modification to Yang et al. as proposed. As stated by the Federal Circuit:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is

rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”²

Furthermore, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”³ Applicant submits that both Yang et al. and Sonehara fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner. Specifically, neither Yang et al. nor Sonehara suggest the desirability of utilizing a linear light source having an effective light emission region which is longer than a longitudinal length of the incidence side surface, such as the one the Examiner contends is taught by Sonehara. Indeed, Fig. 9A of Sonehara appears to show a light source 7 that is longer than the light receiving side of the display. However, there is nothing within Sonehara, or Yang et al. for that matter, that describes any benefit for configuring the light source in this manner.

The grounds of rejection contend that a skilled artisan would have found it obvious to make the light source of Yang et al. have an effective light emission region which is longer than a longitudinal length of the incidence side surface of the display, as allegedly shown in Fig. 9A of Sonehara. The grounds of rejection further contend that it would have been obvious in order “to utilize more stable and effective light emission region of the linear light source, since it is

² *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

³ *Id.*, 23 USPQ 2d at 1783-84 (quoting *In Re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

known that electrodes/ends of the linear light source delivers unstable and un-uniform effective light emission.” However, this asserted motivation is not disclosed within the prior art of record. In fact, the only place in which the desirability of providing a linear light source with an effective light emission region which is longer than a longitudinal length of the incidence side surface of the display is in the present application, for example, at page 20, line 14 through page 23, line 8. When the only express motivation for combining independent features disclosed in independent references is found in the application itself, impermissible hindsight reconstruction is afoot. Therefore, the combination of Yang et al. and Sonehara is improper and does not render the subject matter of claim 1 obvious. Claim 1 is, thus, patentable over the asserted prior art references.

For at least the same reasons as discussed above in regard to independent claim 1, dependent rejected claims 5, 9 and 10 are also believed to be patentable over the asserted prior art.

In addition, in a back-lighting system as shown in Sonehara, the light is usually scattered in a diffused layer. On the other hand, in a front-lighting system, it is not preferred to use the light pipe having the diffused layer due to shortage of contrast and the disorder of display. (See page 2 of the instant application). In the back-lighting system, no shade appears, regardless of the length of effective light emission region. However, in the front lighting system, the shade could appear.

The present invention provides the effective light emission region longer than the incident surface of the light pipe for preventing the shade in the front-lighting system. See page 20, lines 14-25.

Sonehara does not teach applying the light source to a front lighting system. Although Yang teaches a front lighting system, Yang is silent about prevention of the shadow.

There is no teaching in the cited references for prevention of the shade by changing the effective light emission region. For this additional reason, claim 1, and all claims dependent thereon, specifically claims 5, 9 and 10, is patentable over the asserted combination of references.

Patentability of New Claims

For additional claim coverage merited by the scope of the invention, Applicant has added new claims 11 and 12. Applicant submits that the prior art does not disclose, teach, or otherwise suggest the combination of features contained therein.


Conclusion

In view of the foregoing amendments and remarks, the application is believed to be in form for immediate allowance with claims 1-12, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/695,306

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kevin M. Barner
Registration No. 46,075

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 6, 2004

Attorney Docket No.: Q61458